

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

Ex parte CHARLES R. BRENNAN

APR 21 1997

Appeal No. 95-0136  
Application 07/865,941<sup>1</sup>

PAT & TM OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

HEARD: March 3, 1997

Before MCCANDLISH, Senior Administrative Patent Judge and LYDDANE and STAAB, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1, 6 and 9 through 12. Claims 8 and 13, which are the only other claims pending in the application, stand allowed (Paper No. 31, dated June 25, 1996).

The subject matter on appeal is directed to a drumstick.

<sup>1</sup> Application for patent filed April 9, 1992.

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Claim 1 is exemplary of the invention and reads as follows:

1. A drumstick comprising an elongate member including a strike portion having a circular cross-section and terminating at a strike tip, and a handle portion terminating at a butt end, said handle portion being of generally triangular cross-sectional configuration and having three substantially equal length sides, the handle portion extending approximately  $\frac{3}{8}$  of the length of the drumstick from the butt end toward the strike tip.

The references of record relied upon by the examiner in rejections of the claims under 35 USC 103 are:

Russell	3,608,419	Sep. 28, 1971
Cordes	3,722,350	Mar. 27, 1973
Huslig	3,866,508	Feb. 18, 1975
Harrison	3,893,364	Jul. 8, 1975
Mader et al (Mader)	4,969,231	Nov. 13, 1990

Claims 1 and 11 stand rejected under 35 USC 103 as being unpatentable over Harrison in view of Mader.

Claim 12 stands rejected under 35 USC 103 as being unpatentable over Huslig in view of Mader and either Russell or Cordes.

Claims 6, 9 and 10 stand rejected under 35 USC 103 as being unpatentable over Harrison in view of Mader and either Russell or Cordes.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by the examiner and the appellant, we refer to pages 4 through 21 of the

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examiner's answer and to pages 8 through 18 of the appellant's brief (Paper No. 14, filed October 4, 1993) for the full exposition thereof.

#### OPINION

In arriving at our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art, and to the respective positions advanced by the appellant and by the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to all claims on appeal. Our reasoning for this determination follows.

In rejecting claims under 35 USC 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)). A rejection

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based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has also repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings in the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). That court has also cautioned against focussing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as § 103 requires. See, e.g., Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

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With this as background, we have carefully considered the examiner's findings with respect to the patents to Harrison and Mader as applied in the rejection of claims 1 and 11 under § 103 and with respect to the patents to Huslig and Mader as applied in the rejection of appealed claim 12. With regard to the patent to Harrison, we agree with the examiner's position that Harrison discloses a drumstick with a strike portion having a circular cross-section terminating in a striking tip and which includes a handle portion 12 terminating at a butt end 14. However, the handle portion has opposed flattened sides 18, 19 (Figure 1 and 3 through 5) or 18', 19' (Figure 2a) rather than a "generally triangular cross-sectional configuration and having three substantially equal length sides" as recited in appealed claim 1.

Although the examiner has taken the position that the handle of Harrison

could be interpreted within the broadest interpretation of "substantially" and "generally" to have three sides "substantially" equal in length and a "generally" triangular cross-sectional configuration [answer, page 5],

we do not agree. We note that during prosecution, claims in a pending application are to be given their broadest reasonable interpretation. See In re Zletz, 893 F.2d 319, 13 USPQ2d 1320, 1321-1322 (Fed. Cir. 1989). It is not at all apparent how the

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opposed flat sides of the drumstick handle of Harrison (as depicted in Figures 2a and 3) can provide the "generally triangular cross-sectional configuration" with "three substantially equal length sides" as required by appealed claim 1 absent a distorted interpretation of the terms "generally" and "substantially."

Furthermore, we also agree with the examiner's position that the patent to Huslig discloses a drumstick 20'' (Figure 11) with an elongated strike portion having a circular cross-section and terminating in a striking tip 12'' and which includes a handle portion terminating at a butt end. However, once again, the handle portion has opposed generally flattened side surfaces 22'' and 24'' (Figures 9 rather than a "generally triangular cross-sectional configuration and having three substantially equal length sides" as recited in appealed claim 1 from which claim 12 depends. The examiner has again taken the position that the handle of Huslig

could be interpreted within the broadest interpretation of "substantially" and "generally" to have three sides "substantially" equal in length and a "generally" triangular cross-sectional configuration [answer, page 9],

and, again, we do not agree with this position for the reasons stated above.

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Therefore, while both Harrison and Huslig disclose a drumstick, neither discloses the handle of the drumstick as being of "generally triangular cross-sectional configuration and having three substantially equal length sides" as required by appealed claim 1 (and by appealed claim 12 which depends therefrom). We have also carefully considered the teachings of the patent to Mader which certainly discloses a handle of "generally triangular cross-sectional configuration and having three substantially equal length sides" (note Figures 1, 5 and 14). However, the handle disclosed in the patent to Mader is "for a hand tool" (column 1, line 7), and is provided with the triangular (polygonal) shape depicted in the drawing figures "so that it will not roll" (column 2, line 33) and "to permit improved gripping of the handle and use of the tool, even in the presence of greases and oils" (column 2, lines 38-39).

Like the appellant, we find nothing in the applied references that would have provided any suggestion or motivation to modify the shape of the handle of the drumsticks of Harrison or Huslig to have the shape of the handle of the hand tool taught by Mader. As stated in W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983),

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[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.


It is our conclusion that the only reason to combine the teachings of the applied references in the manner proposed by the examiner results from a review of appellant's disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejections of appealed claims 1, 6 and 9 through 12 under 35 USC 103, which rejections are all predicated on the propriety of the combination of the teachings of Harrison or Huslig with those of Mader. We have also considered the teachings of Russell and Cordes applied in the new ground of rejection of claims 6, 9 and 10 set forth in the examiner's answer, but we find nothing therein to cure the deficiencies noted above with respect to the patents to Harrison, Huslig and Mader.



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Accordingly, the decision of the examiner rejecting claims 1, 6 and 9 through 12 under 35 USC 103 is reversed.

REVERSED

  
HARRISON E. MCCANDLISH, Senior  
Administrative Patent Judge

Will. E. Lyddane  
WILLIAM E. LYDDANE  
Administrative Patent Judge

BOARD OF PATENT

APPEALS AND

## INTERFERENCES

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